

REMARKS/ARGUMENTS

These remarks are made in response to the Office Action of April 1, 2008 (hereinafter Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. The Office is expressly authorized, however, to charge any deficiencies or credit any over-payments to Deposit Account 50-0951.

Response to Amendment

It was asserted in the last paragraph on page 2 of the Office Action that Applicant fails to show an actual reduction to practice.

It is noted that Applicants were trying to show prior conception coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice), not an actual reduction to practice.

It was also asserted in the first paragraph on page 3 of the Office Action that there is no evidence to establish conception.

It is noted that an Invention Disclosure is a standard form for inventors to record their conception of an invention and is commonly accepted as evidence of prior conception. The Invention Disclosure attached with the previous response clearly provides demonstrative evidence and is a complete disclosure submitted to the in-house patent department of the assignee. The Examiner has not explained why the Invention Disclosure is insufficient to establish a conception of the invention.

It was further asserted in the last paragraph on page 3 of the Office Action that there is no evidence provided by the Applicant in the critical period which is the time between the time just prior the filing date of Sinclair to the filing date of this application.

It is noted that Applicants provided communications (Exhibits B-F) between the assignee's in-house counsel and the outside counsel retained by the assignee during the critical time period, clearly showing that the outside counsel has worked diligently in preparing the application until the filing of the application (constructive reduction to

practice). The Examiner has not explained why the submitted evidence is insufficient to establish diligence.

Finally, Applicants would like to point to the highlighted sentences in the following paragraphs in MPEP 715.07:

The purpose of filing a [37 CFR 1.131] affidavit is not to demonstrate prior invention, per se, but merely to antedate the effective date of a reference. See In re Moore, 58 CCPA 1340, 444 F.2d 572, 170 USPQ 260 (1971). Although the test for sufficiency of an affidavit under Rule 131(b) parallels that for determining priority of invention in an interference under 35 U.S.C. 102(g), it does not necessarily follow that Rule 131 practice is controlled by interference law. To the contrary, "[t]he parallel to interference practice found in Rule 131(b) should be recognized as one of convenience rather than necessity." Id. at 1353, 444 F.2d at 580, 170 USPQ at 267. Thus, "the 'conception' and 'reduction to practice' which must be established under the rule need not be the same as what is required in the 'interference' sense of those terms." Id.; accord, In re Borkowski, 505 F.2d 713, 718-19, 184 USPQ 29, 33 (CCPA 1974).

*One difference is that in interference practice a reduction to practice requires a proof that a utility was known, whereas under 37 CFR 1.131 practice, proof of a utility must be shown only if the reference discloses a utility. In re Wilkinson, 304 F.2d 673, 134 USPQ 171 (CCPA 1962); In re Moore, 444 F.2d 572, 170 USPQ 260 (CCPA 1971). Where proof of utility is required, whether or not test results are required to establish the utility of the subject matter in question depends on the facts of each case. The ultimate issue is whether the evidence is such that one of ordinary skill in the art would be satisfied to a reasonable certainty that the subject matter necessary to antedate the reference possessed the alleged utility. In re Blake, 358 F.2d 750, 149 USPQ 217 (CCPA 1966). Also, in interference practice, conception, reasonable diligence, and reduction to practice require corroboration, **whereas averments made in a 37 CFR 1.131 affidavit or declaration do not require corroboration; an applicant may stand on his or her own affidavit or declaration if he or she so elects. Ex parte Hook, 102 USPQ 130 (Bd. App. 1953).***

In view of the above, Applicants maintain that prior conception coupled with diligence during the critical period has been established and Sinclair is not available as prior art reference.

Claims Rejections – 35 USC § 103

Claims 1-2, 4, 6-8, 10, 12-14, and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,867,162 to O'Leary, *et al.* (hereinafter O'Leary), in view of U.S. Published Patent Application 2005/0010693 to Sinclair, *et al.* (hereinafter Sinclair), and further in view of U.S. Patent 5,726,688 to Siefert, *et al.* (hereinafter Siefert). Claims 5, 11, and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Leary, Sinclair, and Siefert and further in view of U.S. Patent 6,901,559 to Blum, *et al.* (hereinafter Blum).

Although Applicants respectfully disagree with the rejections, Applicants have amended the claims so as to expedite prosecution of the present application by emphasizing certain aspects of the invention. However, such amendments should not be interpreted as the surrender of any subject matter, and Applicants expressly reserve the right to present the original version of any of the amended claims in any future divisional or continuation applications from the present application.

Applicants have amended independent Claims 1, 7, and 14 to further emphasize certain aspects of the invention. As discussed herein, the claim amendments are fully supported throughout the Specification. No new matter has been introduced by the claim amendments.

The Claims Define Over The Prior Art

Although it is believed that all the rejections under 35 USC 103 are moot because Applicants' prior conception coupled with due diligence from a date prior to the effective

date of Sinclair precludes Sinclair's being a prior art reference, Applicants nonetheless provide the following comments.

O'Leary discloses a method for displaying and editing a picklist in a drop-down menu of a graphical user interface (GUI) of a computer. As shown in Fig. 3 of O'Leary, the drop-down menu 300 includes a command section 304, a picklist section 308, and a remove option section 312. The region of the command section 304 is static and non-user alterable. A user is permitted to selectively remove user-specified entries from the picklist section 308 of the drop-down menu.

It is noted that in O'Leary new entries are always added to the top of the picklist section 308. Therefore, the picklist of O'Leary is not sorted in the sense of the present invention.

It is also noted that the list of previously opened files in the picklist section 308 in O'Leary is not equivalent to a list of user-named variables in the sense of the present invention. Items in the list of recently opened files in O'Leary might contain files that the user modified (e.g., created and named), but might also include files that the user has viewed without modification, and those files might be user-created or system-created.

It is further noted that the entries in the picklist section 308 of O'Leary may contain both user-named files and system-named files, and there is no separation or priority between the user-named files and the system-named files.

It is additionally noted that even comparing the command section 304 and the picklist section 308 of O'Leary with the system-named variables and the user-named variables of the present invention, respectively, O'Leary does not give the same type of order priority to the picklist section 308 as is given to user-named variables in the present invention. A pertinent aspect of the present invention is that, given a list of variables, users are more likely to want to select the variables that they have named (created), which is why the present invention presents the user-named variables first. In contrast, in

O'Leary, the recently opened files have lower priority than existing system menu functions, appearing after the menu functions.

Sinclair discloses in paragraphs [0040] and [0041] that each phone number is given a set of four priority numbers and each number in the set of four priority numbers may represent a characteristic that provides priority to a given phone number. However, it is noted that in the present invention, higher priority is given to the user-named variables as a group and no priority is given to each individual variable. It is also noted that the priority numbers disclosed in Sinclair are not for the purpose of presentation, but rather for the connection management.

Siefert discloses in col. 3, lines 57-64 that certain menu options (such as CIRCLE and LINE) are emphasized using, for example, a different color and larger typeface (see also Fig. 5). However, Siefert does not disclose presenting user-named variables as a group separately and distinctively from the system-named variables as a group.

Accordingly, the cited references, alone or in combination, fail to disclose or suggest each and every element of Claims 1, 7, and 14, as amended. Applicants therefore respectfully submit that amended Claims 1, 7, and 14 define over the prior art. Furthermore, as each of the remaining claims depends from Claim 1, 7, or 14 while reciting additional features, Applicants further respectfully submit that the remaining claims likewise define over the prior art.

Applicants thus respectfully request that the claim rejections under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the

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Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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